

6A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/752,406 | 01/06/2004 | Anthony G. Lutfallah | 1247 P 290 | 3878 |

7590 08/25/2005

PAUL J. NYKAZA, ESQ.
WALLENSTEIN WAGNER & ROCKEY, LTD.
53RD FLOOR
311 SOUTH WACKER DRIVE
CHICAGO, IL 60606-6630

EXAMINER

LUGO, CARLOS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3676

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,406

Applicant(s)

LUTFALLAH, ANTHONY G.

Examiner

Carlos Lugo

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 17-21, 28 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 30-34 is/are allowed.
- 6) ☒ Claim(s) 1-16, 22, 23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ye

DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on June 27, 2005.

Election/Restrictions

2. Applicant's election of Group I in the reply filed on June 27, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-4,13-16, and 22 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,806,900 to Bratcher et al (Bratcher).

Bratcher discloses a window stop (10, see Figures 1-9) that comprises a housing (12) defining a cavity and having a mount structure capable of being mounted to a wall having a thickness between a minimum and a maximum thickness; a bolt (14) mounted inside the housing; biasing means (16 and 18); a cover (32) defining a lip; and a resilient tab or extension member (34). The bolt is moveable between an extended and a retracted position (Figures 7 and 8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5-12,23, and 25-27 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,806,900 to Bratcher et al (Bratcher) as applied to claim 1 above (for claims 5-12), and further in view of US Pat No 6,250,694 to Weiland.

Bratcher fails to disclose that the engagement surface is inclined with respect to the lip and that comprise at least one ridge or protrusion making the surface as a variable surface. Bratcher illustrates that the engagement surface is parallel with respect to the lip.

Weiland teaches that it is well known in the art to have a housing, that is adapted to be placed within a notch or opening of a frame or wall, that includes a resilient tab (44) that includes an engagement surface (46) that is inclined and that includes a plurality of ridges or protrusions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a resilient tab with an engagement surface that is inclined and that includes at least one ridge or protrusion, as taught by Weiland, into a device as described by Bratcher, in order to secure the latch into the notch or opening on a wall or at a frame.

Art Unit: 3676

As to claim 23, Bratcher discloses that the window stop further comprises a projection (24) extending into the cavity and an actuator (16) pivotally mounted to the bolt. The actuator has a hook (56) at one end that engages the projection to retain the bolt (14) in a retracted position when the actuator (16) is in a locked position. The actuator is pivotable from the locked position to a release position so that the hook disengages from the projection to permit the bolt (14) to move towards the extended position.

Allowable Subject Matter

7. Claims 24 and 30-34 are allowed.

Reasons For Allowance

8. The following is an examiner's statement of reasons for allowance:

Claims 24,30 and 34 are allowable over the prior art of record because the teachings of the references taken as a whole do not teach or render obvious the combination set forth, including that at least one of the ridges is inclined away from the lip (claim 24); that the tab has a planar engagement surface distal from the base portion (claim 30); or that each tab has a smooth engagement surface distal from lip and inclined with respect to the lip (claim 34).

Bratcher, as modified by Weiland, discloses a tab with a plurality of ridges that are inclined with respect to the lip. However, Weiland fails to teach that at least one of the ridges is inclined away from the lip or that the makes a planar engagement surface distal from the base portion.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

9. Applicant's arguments filed on June 27, 2005 have been fully considered but they are not persuasive.

Regarding applicant's statement with respect to the previous election requirement (Page 9 Line 6), the applicant previously elects Group I with oral traverse (see last Office Action mailed on March 23, 2005, Page 3 Lines 1-6). However, since the applicant did not provide any argument, the election will be considered as an election without traverse.

As to applicant's arguments that Bratcher fails to disclose that the housing has a mount structure capable of being mounted to a wall having a thickness between a range of thickness from a minimum to a maximum thickness as claimed in claims 1,22 and 23 (Page 10 Line 21), Bratcher discloses the invention as claimed.

The applicant argument is based in that Bratcher's device is not capable of being mounted to walls of different thicknesses. The claim language only requires that the wall has a thickness between a minimum and a maximum thickness; not that the mounting structure is capable of receive any wall thickness. At the moment, Bratcher's device is capable of receive a wall having a thickness selected from a range between a maximum and a minimum thickness.

As to applicant's arguments with respect to provide any motivation or obviousness (Page 12 Line 4), the applicant is reminded that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill without any specific hint or suggestion in a particular reference. In re Bozek, 416 F. 2d 1385, 1390 163USPQ545, 549 CCPA 1969.

In the instant, the devices presented by Bratcher and Weiland are devices that are mounted to a surface. Weiland teaches that it is well known in the art of latches to have a housing, that is adapted to be placed within a notch or opening of a frame or wall, that includes a resilient tab (44) that includes an engagement surface (46) that is inclined and that includes at least one ridge or protrusion in order to secure the latch into the notch or opening on a wall or at a frame.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (Page 13 Line 3), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As to applicants arguments that the amendment presented to claims 24 and 30 overcomes the rejection in view of Bratcher, as modified by Weiland (Page 13 Line 14 and 19), the current amendment overcomes the rejection in view of Bratcher, as

Art Unit: 3676

modified by Weiland, because Weiland fails to teach that at least one of the ridges is inclined away from the lip or that the makes a planar engagement surface distal from the base portion.

With respect to claim 34, the arguments are persuasive; therefore, the rejection is withdrawn.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number 571-272-7058. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

Carlos Lugo
AU 3676

August 12, 2005.


BRIAN E. GLESSNER
PRIMARY EXAMINER